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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,367	04/16/2004	Martin Svehla	COCH-0051-1	8100
22506	7590	12/01/2006	EXAMINER	
JAGTIANI + GUTTAG 10363-A DEMOCRACY LANE FAIRFAX, VA 22030			SONNETT, KATHLEEN C	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/825,367	SVEHLA ET AL.	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 16 April 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-19 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-19 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 4/16/04 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. **Claim 17** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 17 recites the limitation "the same region". There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-4, 7, and 19** are rejected under 35 U.S.C. 102(b) as being anticipated by Kuzma (U.S. 6,096,059) or Lowe (U.S. 5,156,431). Kuzma discloses a clasping tool for controlling an elongate tubular member comprising a first tip (21) constructed to support and limit lateral movement of the tubular member relative to the first tip and to permit longitudinal movement of the tubular member relative to the first tip and a second tip (22) constructed to retain the tubular member between the first and second tips are brought together (see fig. 4b; col. 3 ll. 28-37 of Kuzma; fig. 2 of Lowe).

6. Regarding claims 2 and 3, the elongate tubular member (in this case an electrode carrier member), is not positively recited and therefore the tool must only be capable of holding an electrode carrier member which is connected to a stimulating unit of a prosthetic hearing implant device.

7. Regarding claim 4, the tips are connected to movable arms that are joined at an end opposing the tips, wherein application of a compressive force to the movable arms causes the tips to be brought together (col. 3 ll. 41-49 of Kuzma; abstract of Lowe).

8. Regarding claim 7, see fig. 4b of Kuzma and fig. 2 of Lowe.

9. **Claims 1-4, 10, and 19** are rejected under 35 U.S.C. 102(b) as being anticipated by Thomas (U.S. 2,818,866). Thomas discloses a clasping tool for controlling an elongate tubular member comprising a first tip (7,8) constructed to support and limit lateral movement of the tubular member relative to the first tip and to permit longitudinal movement of the tubular member relative to the first tip and a second tip (11) constructed to retain the tubular member between the first and second tips are brought together (see fig. 1, 6, and 7).

10. Regarding claims 2 and 3, the elongated tubular member appears in the preamble and is not positively recited and therefore the clasping tool must only be capable of controlling an electrode carrier member that is connected to a stimulating unit of a prosthetic hearing device by limiting its lateral movement and permitting longitudinal movement of the member relative to the first tip. This will no longer be addressed in the remaining rejections.

11. Regarding claim 10, the first tip is forked (see fig. 6).

12. **Claims 1-4, 12, 14-16, and 19** are rejected under 35 U.S.C. 102(b) as being anticipated by Huguley (U.S. 1,546,076). Huguley discloses a clasping tool for controlling an elongate tubular member comprising a first tip (2b) constructed to support and limit lateral movement of the tubular member relative to the first tip and to permit longitudinal movement of the tubular

member relative to the first tip and a second tip (1a) constructed to retain the tubular member between the first and second tips are brought together.

13. Regarding claim 12, the first tip (2b) has a looped region having two fork elements and an aperture (see fig. 1).

14. Regarding claim 14, the second tip has a substantially flat region facing toward the first tip (see fig. 3).

15. Regarding claim 16, the substantially flat region extends slightly narrower than the width of the first tip and contacts the tubular member when the tips are brought together (see fig. 2 and 3).

16. Regarding claim 15, the first tip is now being considered tip (1a) and the second tip is being considered (2b) since no limitation in claim 15 prevents such assignment. The flat region of the second tip (2b) is slightly narrower than the width of the first tip (1a) and contacts the tubular member when the tips are brought together.

17. **Claims 1-4, 10-12, 13, and 19** are rejected under 35 U.S.C. 102(b) as being anticipated by Tanner (U.S. 891,509). Tanner discloses a clasping tool for controlling an elongate tubular member comprising a first tip constructed to support and limit lateral movement of the tubular member relative to the first tip and to permit longitudinal movement of the tubular member relative to the first tip and a second tip constructed to retain the tubular member between the first and second tips are brought together.

18. Regarding claims 10 and 11, the first tip (3) has a forked region (where proximal end of aperture is formed). The forked elements curve away from the second tip at the end of the forked region as seen in fig. 3. The elements are considered forked until they meet at the center of connection bar (8).

19. Regarding claims 12 and 13, the first tip (3) has a looped region having two fork elements and an aperture (6). The looped region has a closed end that is curved away from the second tip as seen in fig. 1. The distal end of the tip is curved up at so that it is perpendicular to the rest of the tip.

20. **Claims 1-4, 18, and 19** are rejected under 35 U.S.C. 102(b) as being anticipated by Parks (U.S. 1,119,532) or Thuerig (U.S. 2,642,871). Parks and Thuerig each disclose a clasping tool for controlling an elongate tubular member comprising a first tip constructed to support and limit lateral movement of the tubular member relative to the first tip and to permit longitudinal movement of the tubular member relative to the first tip and a second tip constructed to retain the tubular member between the first and second tips are brought together.

21. Regarding claim 18, the tips have a substantially V-shaped region that forms a holding region for the tubular member when the tips are brought together (see fig. 5 of Parks; see fig. 1 and col. 1 ll. 53-56 of Thuerig).

22. **Claim 5** is rejected under 35 U.S.C. 102(b) as being anticipated by Thuerig. The first and second tips are offset from the longitudinal axis formed by first and second arms by an angle of 0 degrees since the tips are not bent or angled away from the longitudinal axis.

23. **Claims 1-4** are rejected under 35 U.S.C. 102(b) as being anticipated by Hanna (U.S. 4,873,979). Hanna discloses a clasping tool for controlling an elongate tubular member comprising a first tip constructed to support and limit lateral movement of the tubular member relative to the first tip and to permit longitudinal movement of the tubular member relative to the first tip and a second tip constructed to retain the tubular member between the first and second tips are brought together (see fig. 1 and 2; abstract).

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. **Claims 5 and 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanna (U.S. 4,873,979). Hanna discloses the invention substantially as stated above but fails to disclose that the offset angle is approximately 18 degrees. Hanna instead discloses an angle of 30 degrees.

26. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to change this angle to 18 degrees since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art (*In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)). That is, the instrument of Hanna is a microsurgical instrument for grasping needles and tissue (see abstract) and the appropriate bend angle of the tip changes depending on the intended use of the instrument. Smaller bend angles allow access to smaller spaces. Therefore, it would have been obvious to one of ordinary skill in the art to modify the device of Hanna change the bend angle from 30 degrees to 18 degrees since it would involve only routine skill in the art to find an optimum value.

27. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuzma (U.S. 6,096,059) in view of Kuzma (U.S. 4,898,183). Kuzma ('059) discloses the invention substantially as stated above but is silent on the dimensions of the tip of the device.

28. However, Kuzma '183 discloses that it is old and well known in the art to one of ordinary skill in the art that an appropriate thickness for tools that wrap around a cochlear electrode lead in order to aid in insertion of the lead are from 0.2mm to 0.3mm (col. 3 ll. 4-6). Therefore, it

would have been obvious to one of ordinary skill in the art to dimension the tip of Kuzma's ('059) device to be from 0.2mm to 0.3mm thick. According to the specification of the instant application, it is critical for the thickness of the tip to be between 0.1 mm and 0.3mm as a thickness below 0.1 mm may reduce tip strength and above 0.3mm may affect visibility of the user when manipulating the device ([53] of instant spec.). Criticality is given only for the range of 0.1 to 0.3mm since no adverse affect is mentioned for values between 0.1 mm to 0.3mm. One of ordinary skill in the art would have expected the modified device of Kuzma ('059) and applicant's invention to perform equally well with either a wall thickness of 0.2mm as taught by Kuzma ('183) or the claimed 0.1mm since only values outside of the range of 0.1mm to 0.3mm have adverse effects.

29. Therefore, it would have been *prima facie* obvious to modify Kuzma ('059) to obtain the invention as specified in claim 8 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Kuzma ('059).

30. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuzma (U.S. 6,096,059) in view of Thuerig (U.S. 2,642,871). Kuzma discloses the invention substantially as stated above but fails to disclose an aperture in the half-tube region.

31. However, Thuerig discloses that it is old and well known in the art to include a hole in the tip of clasping tool in order to reduce the weight of the instrument (col. 2 ll. 1-3). Therefore, it would have been obvious to one of ordinary skill in the art to modify the device of Kuzma to include an aperture in the half-tube region of the clasping tool as made obvious by Thuerig in order to reduce the weight of the device.

### ***Conclusion***

Art Unit: 3731

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Sonnett whose telephone number is 571-272-5576. The examiner can normally be reached on 7:30-5:00, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KCS  
11/16/2006



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PRIMARY EXAMINER